



BPW

Docket No. 69014-B/GJG

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kiran K. Chada et al.
Serial No.: 10/768,566 Examiner: G. Chandra
Filed : January 29, 2004 Group Art Unit: 1646
For : METHODS OF TREATING OBESITY AND METABOLIC
DISORDERS RELATED TO EXCESS ADIPOSE TISSUE BY
ADMINISTRATION OF S-FRP-5 PEPTIDE

1185 Avenue of the Americas
New York, New York 10036
January 26, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

RESPONSE TO DECEMBER 29, 2005 RESTRICTION REQUIREMENT

This is a Response to the Restriction Requirement issued December 29, 2005 in connection with the above-identified application. Accordingly, a response to the December 29, 2005 Restriction Requirement is now due January 29, 2006 and this Response is being timely filed.

Claims 1-17 are pending in the subject application.

In the December 29, 2005 Restriction Requirement, the Examiner required restriction to one of the following allegedly distinct inventions as follows:

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- I. Claims 1-9 and 17, drawn to a method of reducing the amount of adipose tissue in a subject comprising administering an amount of sFRP-5;
- II. Claims 1-9 and 17, drawn to a method of reducing the amount of adipose tissue in a subject comprising administering a molecule that stimulates expression of sFRP-5 peptide in the subject; and
- III. Claims 10-16, drawn to a method of identifying a molecule that reduces the amount of adipose tissue in a subject comprising contacting a candidate molecule with a tissue which expresses an sFRP-5 peptide wherein the molecule induces the level of expression of sFRP-5 peptide.

The Examiner alleged that the inventions are distinct, each from the other, alleging Inventions I, II and III are unrelated. The Examiner stated that inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP §806.04, MPEP §808.01). The Examiner alleged that the instant specification does not disclose that these methods would be used together; the Examiner alleged that the method of reducing the amount of tissue in a subject comprising administering an amount of sFRP-5 (group I), the method of reducing the amount of adipose tissue in a subject comprising administering a molecule that stimulates expression of sFRP-5 peptide in the subject, (group II), and the method of identifying a molecule that reduces the amount of adipose tissue in a subject comprising contacting a candidate molecule with a tissue which expresses an sFRP-5 peptide (group III) are all unrelated as they comprise distinct steps and utilize different

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products which demonstrates that each method has a different mode of operation.

The Examiner also stated that the distinct steps and products require separate and distinct searches and the inventions of Groups I, II and III would require special disease limitation search using NPL, and other databases. As such, the Examiner alleged that it would be burdensome to search the inventions of Groups I, II and III together.

In response, applicants hereby elect, with traverse, Group I, claims 1-9 and 17.

However, applicants respectfully point out that the restriction between Groups I and II is improper because sFRP-5 administration (purported Group I) is administration "of a molecule effective to stimulate expression of the sFRP-5 peptide in the subject," as explained in the specification. Thus, Groups I and II cannot be properly restricted.

In view of the foregoing, applicants maintain that restriction is not proper under 35 U.S.C. § 121 and respectfully requests that the Examiner reconsider and withdraw the requirement for restriction between Group I and II.

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No fee is deemed necessary in connection with the filing of this Response. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
<i>Gary J. Gershik</i> Gary J. Gershik Reg. No. 39,992	<i>1/26/06</i> Date

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